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IN THE

**Supreme Court of the United States**

**October Term, 1979**

**No. 79-136**

LUTRELLE F. PARKER, Acting Commissioner of  
Patents and Trademarks,

*Petitioner,*

*vs.*

MALCOLM E. BERGY ET AL and  
ANANDA M. CHAKRABARTY,

*Respondents.*

**On Writ of Certiorari to the United States Court of  
Customs and Patent Appeals**

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**MOTION FOR LEAVE TO FILE BRIEF AMICUS  
CURIAE AND BRIEF OF CORNELL D. CORNISH**

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December 12, 1979

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**Motion on Behalf of Cornell D. Cornish and the  
Village of Belle Terre as Amicus Curiae**

This motion is made by Cornell D. Cornish on behalf of himself and the Village of Belle Terre to file this brief as Amicus Curiae in the subject case out of time and by waiving the required consent of the parties in writing. So far the consents of the attorney for Bergy et al and the Solicitor General have been received. The attorney for Chakrabarty has not given his consent.

Respectfully submitted,

CORNELL D. CORNISH  
*as Amicus Curiae*

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**BRIEF OF CORNELL D. CORNISH  
AS AMICUS CURIAE**



### Interest of Amicus Curiae

As a patent attorney, Cornell D. Cornish has a federal right of clear statement to represent inventors of new, useful, unobvious, enablingly disclosed and particularly claimed microorganisms not barred by law before the U.S. Patent and Trademark Office. The right is preemptive. *Sperry v. State of Florida*, 137 USPQ 578 (1963).

As an inventor, he has a property right to emancipation by practicing his profession free from uncontrolled regulations, prior restraint, and content regulation. To this end he has a common law right of publicity to first disclose and to dedicate his microorganisms to the public in a patent unless barred by law. Publicity is such a right. *Zacchini v. Scripps-Howard Broadcasting Co.*, 443 U.S. 562, 577 and n. 13. Neither the patent statutes nor the Constitution supports the doctrine of election of recognition under 35 USC 101, 171, or 161, etc. *In re Yardly*, 493 F. 2d 1389, 181 USPQ 331 (CCPA 1974); *Patents*, Donald Chisum, Sec. 1.04 (5), 1979, p. 1-157. The patent laws overlap in terms of subject matter, just as the patent and copyright laws do. 1 Nimmer, *Copyrights*, Sec. 38 (1975). Obviously this overlap is not complete. *Mazer v. Stein*, 347 U.S. 201; 100 USPQ 325 (1954). That is the reason for having more than one statute. The requirements are different. So are their terms. The clear statement of the law is to provide for dual coverage in appropriate cases, and different coverages simultaneously, save only if the term is increased. *Korzybski v. Underwood & Underwood, Inc.*, 36 F. 2d 727, 3 USPQ 242 (2d Cir. 1929). These are property rights of clear statement whether the subject matter be *parasexually* created, *synergistically* regenerated, *asexually* made and/or *sexually* reproduced.

As an inventor he also has a common law and Constitutional right of clear statement to be free of prior restraint and/or content regulation of his thought and inquiry. *Edwards Case*, Mich. 6 Jacobil, 77 Eng. Rep. 1421 (KB 1609). An attempt was made to limit this doctrine of "no prior restraint" in the *Patent Act of 1790*. It made a patent a matter of grace. However, this Government attempt to deny a patent, e.g., because of subject matter, was eliminated when the *First Amendment* was adopted in 1791. This is supported by the maxim *leges posteriores priores contrarias abrogant*. 1 Bl. Comm. 59-62 (8th ed. 1778). Thus, the subject matter of patents was allowed to develop as a property right and to expand unhindered by federal legislation. *In re Seaborg*, 140 USPQ 662 (CCPA 1964). *The Patent Act of 1793* adopted this policy of clear statement.

As an inventor he also has a statutory right under 35 USC 101 to disseminate and to dedicate his invention to the public in a patent unless barred by law. 42 USC 2181 is a statute that limits the subject matter of a patent. It is essential to me as an inventor that 35 USC 101 be interpreted in such a way that it will not violate established policies of clear statement. This Court has been careful not to limit the ways in which the *First Amendment* can be abridged. *Grossjean v. American Press Company, Inc.*, 297 U.S. 233; *Sai v. The State of New York*, 334 U.S. 558. These are rights of clear statement.

This Court has often expressed concern about the confusion and the retroactivity problems that inevitably would result with a judicial overturning of long lines of precedents. *Federal Baseball Club of Baltimore v. National*

*League of Professional Baseball Clubs*, 259 U.S. 200 (1922); *Toolson v. New York Yankees, Inc.*, 346 U.S. 63; *Flood v. Kuhn*, 407 U.S. 259. See also *Dann v. Johnston*, 425 U.S. 219, 189 USPQ 257 (1976); and *Parker v. Flook*, 437 U.S. 584, 595, footnote 18; 198 USPQ 193 (1978). See also U.S. Patents 3,832,801 and 3,683,550 on man made plants. These plants are *parasexually* created subject matter under 35 USC 101. According to *The Wall Street Journal*, Aug. 18, 1972, the former invention was limited to a single specific "fused cell". The confusion would extend to International Law since living organisms are patentable in foreign countries. See British Patent 1,310,119. Under the *Paris Convention* of 1883 and the *PCT Convention* of 1978 applicants should be allowed to file first here and then in convention countries on living organisms. These are obviously well established policies of clear statement to cover subject matter that is *parasexually* created.

As an inventor, he also has a right in not surrendering microorganisms to the States. The surrender of living organisms from 35 USC 101 would be in derogation of his rights as an inventor. To this end, it would violate established policies of clear statement involving preemption of patents by the Federal Government. *Sperry v. State of Florida*, 137 USPQ 578 (1963). For the *Tenth Amendment* states the obvious. What is not surrendered is retained. *United States v. Darby*, 312 U.S. 100, 124. And what is given up is possessed by the States. *Gibson v. Ogden*, 9 Wheat. 1, 14, 46, 47, 59 (1824); *Livingston v. Van Ingen*, 9 Johns (NY) 507 (1812); *McLain v. Ortmyer*, 141 U.S. 76, 78 4/9 (1891). It is thus essential that the legislative enactment of 35 USC 101 be interpreted so as not to violate this established policy of clear statement. It is consistent with the

plain meaning of the statute. To this end, it is the rule of statutory construction that this legislative enactment be given its intended general, comprehensive and prospective interpretation by applying it alike and with global equality to *all* persons and *any* subject matters within its general purview and scope coming into existence subsequent to its passage. *Commonwealth v. Maxwell*, 271 Pa. 378, 114 Atl. 825 (1921); 25 Ruling Case Law 778.

Moreover, this intended prospective interpretation must be provided so as not to violate the established competitive mandate of the Constitution. This is also a clear policy statement. To this end, the patent system must be open to all with global equality, whether the subject matter be old or new technology, living or dead. Analogues abound. One such analogue is the post office. Also, common carriers are much the same in their prospective duties to new technologies. At common law a carrier owes a duty to the public whatever the subject matter that comes into existence to carry for all to the extent of its capacity, at reasonable rates, and with substantial impartiality. *Michigan Public Utilities Commission v. Duke*, 266 570 U.S. 370. For it has long been pointed out that an unrestrained right of discretion would, through its operation upon the course of trade, tend to build up monopolies and destroy competition. 9 Am. Ju. 557, 1937, citing *Messenger v. Pennsylvania R.R. Co.*, 37 NJL 531; 18 Am. Rep. 754.

These well established common law, constitutional and statutory policies of clear statement are consistent with the plain meaning of 35 USC 101, as well as its legislative history. The flow of action was dominated by the Examiner-in-Chief of the Patent Office. He testified that the prospec-



tive subject matter intended under 35 USC 101, "may include anything under the sun that is made by man." On the other hand, the lonely view of T. Hayward Brown, which was not adopted, was that 35 USC 101 shouldn't open the door to new technology, including new "discoveries in the fields of chemistry, physics, medicine, mathematics, et cetera." This is precisely where the subject inventions and those of Cornell D. Cornish are to be found. See U.S. 3,433,705 and *Hearings*, 82nd Congress, First Session, H.R. 3760, June 13-15, 1951. To give 35 USC 101 anything other than the broadest meaning the plain meaning of the words will bear would obviously violate established policies of clear statement. The plain meaning of the words was to advance the progress of new species, not to suppress or endanger them. The flag of Galileo was clearly intended to be flown then and not to be torn down now. The well established policy of clear statement was to secure and recognize the prospective dissemination and the dedication of inventions to the public in patents coming into existence after the enactment of the patent law. *Korzybski v. Underwood & Underwood, Inc.*, 36 F. 2d 727, 3 USPQ 242 (2d Cir. 1929). And 35 USC 101 was a codification of this law. *Hearings*, 82nd Congress, June 13-15, 1951.

The plain meaning of 35 USC 101 is clearly consistent with prospective subject matter coming into existence subsequent to its passage. To this end, the plain meaning of "any" is *any* invention under the sun really made by humans. On the other hand, the word "any" in 35 USC 101 is clearly limited to "Whoever" invents or discovers a reality based upon sensory perception. By the maxims of statutory interpretation, this means "man made" inven-

tions and discoveries, and those synergistic inventions that are regenerated by the cooperation of divine grace and human activity. *In re Sarkar*, 200 USPQ 132 (CCPA 1978); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 61 (1969); *Sakraida v. Ag-Pro, Inc.*, 425 U.S. 273, 282 (1976); and *Webster's New Collegiate Dictionary*, "synergism", 1953. Thus, they exclude inventions that are not embodied, that are merely ideas, etc. *Parker v. Flook*, 437 U.S. 584. See the maxims: *expressio unius exclusio alterius*, *noscitur a sociis*, *eiusdem generis*, and *reddendo singula singulis*. "Statutes And Their Interpretation," Dean Albert M. Sacks, Program of Instruction For Lawyers, Harvard University, July 18-21, 1979, p. 1412. If this Court finds that the subject inventions were really made by humans, and are not merely ideas, then Cornell D. Cornish, as well as all other inventors, rich and poor, black and white, young and old, well fed and hungry, domestic and foreign, male and female, and those unable to publish elsewhere, who wish to be emancipated, may seek the same with global equality by recognition in a patent not barred by law. It is our right to keep the delegation to the Patent and Trademark Office clearly in view. *A.L.A. Schechter Poultry Corporation v. United States*, 295 U.S. 495 (1935). It is one of the largest printing houses of technical information in the world. This information is largely available from no other source. Thus, if new reasons are adopted for stopping applicants from going before the Patent and Trademark Office, they should be articulatable reasons. There is a clear analogy here to the criminal law. *Delaware v. Prouse*, 99 S. Ct. 1391 (1979).

Cornell D. Cornish has an interest in this case for the reasons stated in the above-identified motion to permit filing of the attached brief. His interests as a patent attorney and an inventor are believed to be compelling. Indeed, the connection between this case and his interests under the *First Amendment* are clearly before this Court because of the citations in the Solicitor General's Petition for Writ of Certiorari to the United States Court of Customs and Patent Appeals, dated July 1979, in this case. See, e.g., *Red Lion Broadcasting Co. v. FCC*, 395 U.S. 367, 380-381 (1969), cited on the last page of the Petition. See also this Court's view of the unified, general, comprehensive and prospectively operative communications policy of the United States relative to its clear statement in patent and common law policy. *Zacchini v. Scripps-Howard Broadcasting Co.*, 97 S. Ct. 2849 (28 June 1977). Moreover, the connections between these cases and the *First Amendment* have been extensively discussed in the literature. *Taming Red Lion: The First Amendment and Structural Approaches to Media Regulation*, Federal Communications Law Journal, Vol. 31, No. 2, Spring 1979, pp. 215-234; *Cable Television and Content Regulation: The FCC, The First Amendment and The Electronic Newspaper*, New York University Law Review, Vol. 51, No. 1, April 1976, pp. 133, 144; *Human Cannonballs and the First Amendment: Zacchini v. Scripps-Howard Broadcasting Co.*, Stanford Law Review, Vol. 30, No. 6, July 1978, pp. 1185-1209. Cornell D. Cornish is also a resident of Belle Terre, Port Jefferson, New York.

Belle Terre is a quiet, residential community. *Belle Terre v. Boras*, 41 S. Ct. 1536 (1974). It owns land touching

Port Jefferson Harbor. This harbor serves as a main port of entry for oil into Suffolk County. Thousands of tons of oil are involved on an almost daily basis. Oil spillages have been of concern here also to the Federal Government. See the following. The Chakrabarty invention would be especially helpful to us in protecting Belle Terre against oil spills. We thus have a direct property interest in the allowed claims. Their dedication to us will result from a patent thereon.

Belle Terre is a village on Long Island. It has a property interest in publicly owned, oil-free beaches and fishing grounds, not only at Port Jefferson. The residents of Belle Terre have a property interest in oil-free beaches and fishing grounds in the whole of Suffolk County. The Chakrabarty invention would be a property interest to the residents of Belle Terre in protecting Long Island's shores and adjacent fishing grounds from oil spills at George's Bank. According to the *New York Times*, October 12, 1979, Americans landed fish worth \$82 million from the Bank. Foreigners took another \$85 million. Over the next 20 years the total catch might be worth \$3.3 billion. Government geologists estimate the most probable yield from the lease area involved to be 123 million barrels of oil and 870 billion cubic feet of gas, worth \$7 billion over the 20-year life of the field. A patent on the allowed claims is thus a valuable property even after 17 years.

According to the *New York Times*, October 31, 1979, there have been law suits to stop the sale of oil and gas leases at George's Bank. Also at stake is the continued viability of the George's Bank, which for almost 300 years has been one of the world's richest fishing grounds. Its tourist

industry last year netted Massachusetts alone \$1.7 billion. Obviously, the Chakrabarty invention could be of interest to New England as well. The acceptance of the allowed claims in a patent would thus be a valuable property asset to us which we could use for many important purposes.

According to the *New York Times*, November 10, 1979, 84 percent of the households on Long Island are heated by oil. The Port Jefferson plant of the Long Island Lighting Company is currently run by oil that comes in by tanker through Port Jefferson Harbor. It is substantially the only source of electricity for all the residents of Belle Terre. Thus, the acceptance of the allowed claims is a vital property to us. It would dedicate a vital property interest to us.

According to the *New York Times*, November 6, 1979, the Government has petitioned this Court in the case of *United States v. Ward*, No. 79-384. In 1978, the Government's petition said, 14,741 oil spills were brought to the Coast Guard's attention. These resulted in 8,000 civil penalty cases, including 1,400 against individuals. Moreover, these oil spills are important to the Environmental Protection Agency, regulations governing the discharge of hazardous substances, other than oil, into Federal waterways, and the Clean Water Act. According to 33 USC the oil spills prohibited means oil of any kind or in any form, including fuel oil, sludge, and oil refuse. See e.g., 33 USC 407, 411, 413, 432, and 433. It is obvious, therefore, why we have a property interest in accepting the allowed claims.

Additionally, Cornell D. Cornish has a property interest in a covenant running with land on Port Jefferson Harbor. This covenant, which is still in effect, is recited in the deed

of the land recorded in Suffolk County, N.Y., in *Liber 1033 cp 578*, for land transferred from Belle Terre Park Co., Inc. to the Harbor Head Corporation. This covenant is certified in writing by the Home Title Division, Chicago Title Insurance Company. It provides that no nuisance shall be maintained on said property. In connection with this land a request by Mr. Samuel S. Giles for a Department of the Army permit for Application No. 74-139 to construct a marina at Mt. Misery Point, Town of Brookhaven, Port Jefferson Harbor was denied. This denial was dated 2 August 1977 in accordance with Title 33 CFR 325.8 (b), Processing of Department of the Army permits (as published in the *Federal Register* on Tuesday, 19 July 1977; Vol. 42-No. 138). According to this denial by John J. Chisholm, LTC, Corps of Engineers, the vicinity of this land "is of high biological importance." It involves "shallow water habitat in Port Jefferson Harbor of value to fish and wildlife resources." Obviously, therefore, Cornell D. Cornish for himself and the Village of Belle Terre has an interest in the specific microorganism for cleaning up oil spills that was invented by the applicant Chakrabarty in this case. We specifically have a direct and immediate property interest in the dedication of the allowed claims.

As referred to in the below mentioned report, a map of Port Jefferson Harbor, Belle Terre, Port Jefferson and Long Island is attached to the report entitled, *Port Jefferson Harbor, New York, Review of Reports*, which was published by the U.S. Army Engineer District, New York, August 1964, Revised July 1966. The proximity of Long Island to George's Bank is also shown by this map. The many places we could use the property from the dedication of the allowed claims is obvious from the map.



As mentioned in the above-identified *Review of Reports*, the projected trend of petroleum commerce in Port Jefferson Harbor is based on three factors: population increase, diversion to Port Jefferson Harbor of a portion of the petroleum traffic of neighboring shallow-draft ports in Suffolk County, and continued use of oil by the Long Island Lighting Company power plant. The population of Suffolk County, which comprises the tributary area of Port Jefferson Harbor, has been increasing at an accelerated rate, greater than the national average. The population was about 1,000,000 in the 1970's. It is expected to increase to about 3,000,000 in 2020. In 1970 the domestic petroleum commerce in Port Jefferson Harbor was estimated to be about 1,010,000 tons, and the foreign commerce to be about 450,000 tons. In 2020 the total petroleum commerce is projected to be about 3,000,000 tons. That is estimated to be worth about \$1 billion/year. This is in addition to the value of the dedication of the allowed claims to us in a patent.

There is one 100-acre County Park on Port Jefferson Harbor. There are numerous Belle Terre Village parks on Port Jefferson Harbor to which Cornell D. Cornish and all the residents of Belle Terre have a property interest by dedication. It would be a property interest to us in the use of these parks to have Chakrabarty disclose his invention to the public in a patent in an oil eating composition of matter, manufacture, material, art, and improvements thereof. Moreover, it would be a direct and valuable property interest to us to have Chakrabarty dedicate his invention and improvements to the public, save for the limited exclusive rights therein mandated by Congress. These inventions are public goods, like national defense, which would

be subject to free-riders except for the system of Government mandated by the Constitution. Possibly they wouldn't exist at all without the open and personal disclosures in patents. New technology was the result beginning from the adoption of the *Bill of Rights* and/or before. It is in a direct line from the letters patent used to implement the Magna Carta. *The Magna Carta and the Tradition of Liberty*, L. B. Wright, 1976, p. 58. They are directly related to the patents used for dedication by Galileo. All those inventors who were recognized and/or emancipated after Galileo according to the clear statements of the Constitution and the clear intention of Congress used patents for dedication. This dedication of property was clearly intended under 35 USC 101 and the patent laws going back to the *Patent Act of 1793*. Our property interest in accepting the allowed claims for dedication to the public is clear, direct, immediate and valuable. We shouldn't be deprived of this valuable property, nor should it be surrendered except by statute. And such a statute must be explicit. It should not be implied by this Court. *U.S. Constitution, Art. IV, sec. 3, cl. 2*; 5 USC 553 (A.P.A.); and *Public Citizen, Inc. v. Sampson*, 180 USPQ 497 (DC, DC 1974).

### **The Constitutional Provisions, Statutes and Regulations Involved**

For convenience, the relevant constitutional, statutory and regulatory provisions are set forth in the Appendix, which appears at the conclusion of this brief.

### Summary of Argument

The Patent and Trademark Office must have wide discretion in rejecting the claims of the applicants without prejudice to their refiling of the rejected claims in Continuing or Reissue Applications.

## ARGUMENT

### I.

**The Patent and Trademark Office must have wide discretion in mediating the issuance of patents in such a way as to free it from not insubstantial constitutional doubts.**

The obligation to determine what type of discovery is sought to be patented must precede the determination of whether that discovery is, in fact, new or obvious. *Parker v. Flook*, 437 U.S. 584 (1978). As part of the mediating process the Patent and Trademark Office has been able to determine what type of discovery is sought to be patented, i.e., one that is not banned by law from disclosure in a patent. Moreover, since claims have been allowed, the Patent and Trademark Office has been able to determine that the disclosures are entitled to issuance in patents without content regulation, i.e., that the claimed inventions are not only new and unobvious, but that they are also useful, enablingly disclosed and particularly claimed.

Claims have also been rejected under 35 USC 101. This is part of the mediating process. But a statute should be interpreted, if fairly possible, in such a way as to free it

from not insubstantial constitutional doubts. *Lynch v. Overholser*, 369 U.S. 705, 710 (1962). Thus, the Patent and Trademark Office must have wide discretion in mediating the issuance of patents in such a way as to free it from not insubstantial constitutional doubts.

### II.

**In view of the allowance of claims, the rejection of other claims should be upheld without prejudice to the applicants' filing of continuing and/or reissue applications as part of the mediating process.**

As part of the mediating process the Patent and Trademark Office has wide discretion in mediating the issuance of continuing and reissue patent applications as patents. *Grant v. Raymond*, 31 U.S. (6 Pet.) 218 (1832); *O'Reilly v. Morse*, 56 U.S. (4 How) 62, 112 (1853). To this end, it can even reject claims while permitting the applicants to file continuing and/or reissue patent applications on the rejected claims. At this time the applicant may choose to abandon the claims that were rejected as part of the mediation process. On the other hand, the applicant can choose to file a continuing application and a reissue application. The latter has the advantage of publication before reissuance as a patent. This has the advantage of gaining the consent of the public to the reissuance of the patent. On the other hand, the public can sometimes show that the reissuance of the patent is banned by law. If this Court agrees, therefore, in view of the allowance of claims, and the issues not briefed, the rejection of the rejected claims should be upheld without prejudice to the applicants' filing of a continuing and a reissue application as part of



the mediating process. This would free 35 USC 101 from not insubstantial constitutional doubts that might otherwise arise. It would also put applicants on notice of the Patent and Trademark Office's intention to enforce the decision of the Court. The FTC does something similar. 16 CFR Sec. 1.1-1.4.

The Guidelines relating to the reissue statute 37 CFR 1.175 and 1.291, as amended effective March 1, 1977, are found in the December 12, 1978 *Official Gazette*, 977 OG 11. The *Rules of Practice In Patent Cases* relating to Reissues are found in the February 22, 1977 *Official Gazette*. On October 4, 1976, notice was given in the *Federal Register* (41 FR 43729) of the rules, which are found in Title 37 of the *Code of Federal Regulations* relating to Reissue Applications. The filing of protests under 37 CFR 1.291, is discussed in 977 OG 12 *et seq.* Relevant sections of the *Manual of Patent Examining Procedure*, comprise Sections 1309.02 and 721.01. The thrust of all these rules and regulations is to have the public help the Patent and Trademark Office avoid issuing patents that are barred by statute. Indeed, the problem of workload was seriously addressed in *Parker v. Flook*. Moreover, Federal Judges can direct patentees to seek reissue. 451 PTCJ A-14, October 25, 1979. Inventorship is one of the questions addressed in such instances, i.e., whether this invention was made by "man" or not.

### Conclusion

**This Court should uphold the rejection of claims as part of the mediating process in issuing patents without prejudice to the applicants to file continuing and/or reissue applications on the rejected claims.**

Respectfully submitted,

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# **APPENDIX**

## **United States Constitution and Statutes**

### **The Constitutional Provisions**

U.S. Constitution, Article IV, Section 3, clause 2 provides in pertinent part: "The Congress shall have Power to dispose of and make all needful Rules and Regulations respecting the territory or other property belonging to the United States."

First Amendment. Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof, or abridging the freedom of speech, or the press; or the right of the people peaceably to assemble, and to petition the Government for the redress of grievances.

Tenth Amendment. The powers not delegated to the United States by the Constitution nor prohibited by it to the States, are reserved to the States respectively, or to the people.

### **United States Code**

#### **Title 35 — Patents**

**Patent Act of July 19, 1952,**

**C. 950, Sec. 1, 66 Stat. 792**

### **Section 101, Inventions patentable**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.